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**TITLE AMENDMENT:**

Please replace the title of the invention with the following:

**“Method, Apparatus and System for Enabling a New Data Processing Device Operating State”**

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**REMARKS**

Claims 1-47 stand rejected herein. Claims 2, 19 an 33 have been canceled herein without prejudice to the filing of continuations and/or divisionals while Claims 1, 4, 16, 17, 29, 32, 35 and 47 have been amended herein. Applicants respectfully request reconsideration of pending Claims 1, 3-18, 20-32 and 34-47 in light of the amendments and remarks herein.

**Title of the invention**

The Examiner suggests that the title of the invention is not descriptive and requests a new title that is clearly indicative of the invention to which the claims are directed. Applicants respectfully traverse the Examiner's objections, but in the interest of moving forward with the substantive examination of the application, Applicants have amended the title of the invention herein. Applicants therefore respectfully request the Examiner to withdraw the objection to the title.

**35 U.S.C. §112**

Claims 1-16 and 29-47 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter which Applicants' regard as the invention. More specifically, the Examiner cites various deficiencies in the claims (e.g., lack of antecedent basis for various phrases). Applicants respectfully submit that Claims 1, 16, 29, 32 and 47 have been amended herein to address the Examiner's concerns. Applicants therefore respectfully request the Examiner to withdraw the 35 U.S.C. § 112, second paragraph, rejection to Claims 1-16 and 29-47.

**35 U.S.C. §101**

Claims 32-47 stand rejected under 35 U.S.C. § 101 because the Examiner submits that the claimed invention is directed to non-statutory subject matter. The Examiner submits that the "medium" in these claims is directed to a signal and that signals comprise non-statutory subject matter. Applicants respectfully traverse the Examiner's rejection. In the interest of moving forward with substantive examination of the

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application, however, Applicants respectfully submit that Claim 32 has been amended to include the phrase “tangible”, this making clear that the machine-accessible medium of Claims 32-47 comprises a tangible medium. Applicants therefore respectfully request the Examiner to withdraw the 35 U.S.C. § 101, second paragraph, rejection to Claims 32-47.

35 U.S.C. §102

Claims 1, 6-8, 17-18, 21, 23-25, 32 and 37-39 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Microsoft, OnNow Power Management (hereafter “Microsoft”). Specifically, the Examiner submits that Microsoft teaches each element of independent Claims 1, 17 and 32. Applicants’ traverse the Examiner’s rejection.

First and foremost, Applicants respectfully submit that the Examiner has fundamentally misunderstood the claimed invention. As described in the specification:

“According to embodiments of the present invention, data processing devices (hereinafter collectively referred to as “PCs”) may be configured to include and/or recognize a new operating “state” (hereafter referred to as “Visual Off”) in which the device appears to the user to be powered off, but wherein the device is actually capable of processing requests. The concept of “states” is described in further detail below. The Visual Off state essentially convinces users that their PCs are off by appearing to act as users typically expect when they turn off their machines. In reality, however, the PCs may still be operating and be available to process requests (e.g., local requests and/or requests from other devices coupled to the PC). In this manner, users may continue using their PCs as familiar desktop processing devices while the PC is on, and the PC may continue to be available to process requests although seemingly powered down.”

Specification, Paragraph 0013 (emphasis added)

Independent Claims 1, 17 and 32 capture this invention by clearly articulating that data processing devices may be transitioned into a Visual Off state rather than being turned off, where the Visual Off state is described as a state in which all audible and visual indicators on the data processing device and any attached HIDs are turned off.

As a preliminary matter, Applicants respectfully submit that the rejection of Claims 1, 6-8, 17-18, 21, 23-25, 32 and 37-39 is facially deficient because the Examiner has not established a prima facie case of anticipation. As is well-established, in order to establish a prima facie case of unpatentability under 35 U.S.C. § 102, the cited prior art must disclose very limitation of the claims being rejected. Therefore, if even one claim element or limitation is not disclosed by the references, a prima facie case is not established. Additionally, as the Federal Circuit has noted,

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"As adapted to *ex parte* procedure, Graham [v. John Deere Co.] is interpreted as continuing to place the 'burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103.' (emphasis added)

*In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967)). The Examiner thus has the burden of producing a factual basis for his rejection and for establishing anticipation by identifying how each recited claim element is allegedly disclosed by the cited reference. Applicants respectfully submit that the Examiner has failed to establish such a *prima facie* case and has merely provided bare allegations that the reference anticipates the claims. For example, with respect to the first element of Claims 1 and 32, the Examiner recites the claim element and simply states "in the Overview of OnNow Power Sates and Power Policy section and with figure 1". Similarly, with respect to the remaining elements of the claims, the Examiner makes general references to the Overview section of Microsoft and jumps to the conclusion that this section anticipates the claims. Applicants respectfully submit that the Examiner has completely failed to identify "the factual basis for its rejection", as required by the Federal Circuit. The Examiner's general allegations do not rise to the level of meeting the requisite burden of proof. The rejection of Claims 1, 6-8, 17-18, 21, 23-25, 32 and 37-39 is thus facially deficient for at least these reasons.

Even assuming arguendo the Examiner had met his burden of proof, Microsoft simply does not anticipate each element of independent Claims 1, 17 and 32. Applicants own perusal of Microsoft indicates that while Microsoft describes different states on a computer, there is no description of a "visual off" state, as claimed herein. The "visual off" state is essentially a state that tricks a user into believing that the device is off by turning off all audio and visual indicators and any attached HIDs. Thus, rather than the scenario described in Microsoft which essentially describes a "low-power sleep state", the "visual off" state is not tied to the state of the data processing device itself. In other words, the data processing device may enter into a "visual off" state and remain running at full capacity. It may, however, also run when the machine enters a lower power state. The critical difference herein is that the "visual off" state is essentially a state (regardless

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of the power level of the data processing device) that affects the audio and visual indicators and HIDs attached to the data processing device, to "trick" a user into believing that the device is in fact off. Independent Claims 1, 17 and 32 all describe this feature (transitioning into a "visual off" state). Nothing whatsoever in Microsoft describes this type of feature. Applicants therefore respectfully request the Examiner to withdraw the rejection to Claims 1, 6-8, 17-18, 21, 23-25, 32 and 37-39 under 35 U.S.C. §102.

35 U.S.C. §103

Claims 2-5, 9-16, 19-20, 22, 26-31, 33-36 and 40-47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Microsoft. Applicants respectfully traverse the rejection.

First and foremost, Applicants respectfully submit that Claims 2, 19 and 33 have been canceled herein without prejudice to the filing of continuations and/or divisionals. Any rejections to these claims is therefore moot. With respect to the remaining claims, Applicants respectfully submit that since Microsoft did not disclose each and every element of the independent claims, it also does not teach or suggest the elements of the dependent claims (which incorporate all elements of the independent claims). The Examiner even concedes that Microsoft does not explicitly describe turning audible and visual indicators off, as claimed, but suggests that transitioning the device between a sleep state and a working state teaches this element. Applicants strongly disagree. Specifically, as previously discussed, while in the "visual off" state, the data processing device is still operating and available to process requests (Specification, Paragraph 13), in direct contrast with a sleep state in which the device is unavailable to process requests. Applicants therefore respectfully submit that Microsoft does not render pending Claims 3-5, 9-16, 20, 22, 26-31, 34-36 and 40-47 unpatentable and Applicants respectfully requests the Examiner to withdraw the rejection to Claims 3-5, 9-16, 20, 22, 26-31, 34-36 and 40-47 under 35 U.S.C. §103.

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**CONCLUSION**

Based on the foregoing, Applicants respectfully submit that the applicable objections and rejections have been overcome and that pending Claims 1, 3-18, 20-32 and 34-47 are now in condition for allowance. Applicants therefore respectfully request an early issuance of a Notice of Allowance in this case. If the Examiner has any questions, the Examiner is invited to contact the undersigned at (714) 669-1261.

If there are any additional charges, please charge Deposit Account No. 50-0221.

Respectfully submitted,

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